

R E M A R K S

A. INTRODUCTION

Claims 49-62, 70 and 73-80 were pending subject to a restriction requirement that is traversed below.

Upon entry of this Reply, the Specification will be amended. No amendment is made to the claims.

B. ELECTION/RESTRICTION REQUIREMENT

1. Invention I is elected (with traverse)

Applicants elect Invention I (Claims 49-62) for examination with traverse. Applicants request reconsideration of the restriction requirement and examination of all of the pending claims. This reply distinctly and specifically points out errors in the restriction requirement.

2. No prima facie case establishing a requirement of restriction

Applicants traverse the restriction requirement provided in the present Office Action because the Office Action fails to provide a prima facie case that restriction is appropriate.

The conclusion that restriction is appropriate is not supported by substantial evidence or by an articulated explanation in light of any such evidence.

Specifically, there is no evidence offered in support of the finding that subsets of the claims (the alleged “inventions”) differ from one another so significantly that they are “unrelated.” To the contrary, findings in the Office Action (e.g., with respect to the search classifications for the subject matter) contradict a finding that the claims address “inventions” that are “unrelated.” Further, there is no evidence or explanation provided that would support the mere conclusion that examination of all of the pending claims would be a serious burden.

2.01. Findings by the Office

The Office Action states that Invention I is classified in **class 705**, subclass 35; Invention II is classified in **class 705**, subclass 77; and Invention III is classified in **class 705**, subclass 39. [Office Action page 2].

The Office Action thus finds that all of the claimed subject matter is generally defined under **class 705**.

The Office Action states:

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation and effects (MPEP § 802.01 and § 8-6.06). In the instant case, the different inventions have different scopes, furthermore they have different modes of operation thus yielding different results and are not capable of use together for the reason set forth.

[Office Action, page 3].

The Office Action further finds that there would be a serious search and examination burden if restriction were not required because one or more of five identified reasons apply. [Office Action, page 3]. The Office Action does not, however, indicate any particular one (or more) reason, nor does it provide any explanation or evidence in support of any of the listed reasons.

2.02. Classifications

According to the Manual for Patent Classification (accessible at <http://www.uspto.gov/web/patents/classification/>):

This [class 705] is the generic class for apparatus and corresponding methods for performing data processing operations, in which there is a significant change in the data or for performing calculation operations wherein the apparatus or method is uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data.

This class also provides for apparatus and corresponding methods for performing data processing or calculating operations in which a charge for goods or services is determined.

This class additionally provides for subject matter described in the two paragraphs above in combination with cryptographic apparatus or method.

SCOPE OF THE CLASS

1. The arrangements in this class are generally used for problems relating to administration of an organization, commodities or financial transactions.
2. Mere designation of an arrangement as a "business machine" or a document as a "business form" or "business chart" without any particular business function will not cause classification in this class or its subclasses.

3. For classification herein, there must be significant claim recitation of the data processing system or calculating computer and only nominal claim recitation of any external art environment. Significantly claimed apparatus external to this class, claimed in combination with apparatus under the class definition, which perform data processing or calculation operations are classified in the class appropriate to the external device unless specifically excluded therefrom.

4. Nominally claimed apparatus external to this class in combination with apparatus under the class definition is classified in this class unless provided for in the appropriate external class.

5. In view of the nature of the subject matter included herein, consideration of the classification schedule for the diverse art or environment is necessary for proper search.

Subclass 35 (“Finance (e.g., banking, investment or credit)”) is directed to subject matter drawn to a computerized arrangement for planning the disposition or use of funds or securities, or extension of credit. Subclass 35 is indented under subclass 1 (“Automated electrical financial or business practice or management arrangement”), which is directed to subject matter wherein an electrical apparatus and its corresponding methods perform the data processing operations, in which there is a significant change in the data or for performing calculation operations wherein the apparatus or method is uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data.

Subclass 39 (“Including funds transfer or credit transaction”) is directed to subject matter drawn to a computerized arrangement for transferring funds by debiting one account and crediting another by the same amount. Subclass 39 is indented under subclass 35, discussed above.

Subclass 77 (“including remote charge determination or related payment system”) is directed to subject matter wherein the determination at a remote vendor site of a payment due or a transfer of funds from a buyer to a remote vendor. Subclass 77 is indented under subclass 64 (“secure transaction (e.g., EFT/POS)”), which is directed to subject matter wherein an exchange of financial data is protected by encryption. Subclass 64 is indented under subclass 50 (“Business processing using cryptography”) which is directed to subject matter including cryptographic apparatus or methods uniquely designed for or utilized in the practice, administration, or management of an enterprise, the processing of financial data, or where a charge for goods or services is determined. [Subclass 50 explicitly excludes “subject matter related to business processing having only nominal recitation of cryptographic processing such as encrypting, scrambling, etc.

Such nominal recitation of cryptography combined with business processing is classified elsewhere.”]

A search on April 22, 2009 of the USPTO Patent Full-text and Image Database (accessible at patft.uspto.gov) for patents classified in both 705/35 and 705/39 yielded 296 issued patents.

A search on April 22, 2009 of the USPTO Patent Full-text and Image Database (accessible at patft.uspto.gov) for patents classified in both 705/35 and 705/77 yielded 23 issued patents.

A search on April 22, 2009 of the USPTO Patent Full-text and Image Database (accessible at patft.uspto.gov) for patents classified in both 705/39 and 705/77 yielded 31 issued patents.

2.03. The Office Action does not Meet the Prima Facie Burden for a Holding of “Independent” (i.e. “Unrelated”) Inventions

The prima facie burden for establishing that claimed subject matter is appropriately restricted as being directed to “independent” (i.e. “unrelated”) inventions has not been met.

The Office Action holds that there are multiple inventions claimed that are “unrelated.” [Office Action, page 3]. A finding that alleged inventions are “unrelated” is a finding of “independence” of the inventions. See MPEP § 802.01 (“‘Independent’, of course, means not dependent>, or unrelated<”).

The term “independent” (i.e., unrelated) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the process are independent inventions. MPEP § 802.01.

Per MPEP § 808.01:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

The Office Action fails the requirement of MPEP § 808.01 to provide any particular reasons for holding that there are multiple inventions claimed that are independent (i.e. “unrelated”). The statement on page 3 (cited above) is a mere statement of conclusion, and therefore inadequate. That the allegedly “different inventions” are different in scope is irrelevant and insufficient; claims must differ in scope from one another. The statement as to “different modes of operation” is conclusory; no reasoning or explanation is given. The statement as to “yielding

different effects” is conclusory; no reasoning or explanation is given. And again, claims must differ in scope to be allowable. Accordingly, difference in scope, alone, cannot be the appropriate basis for a finding of a “different mode of operation” or “different effect.”

The statement as to “not capable of use together for the reason set forth” is conclusory and erroneous. There is no reasoning as to why the various claimed subject matter would be incapable of use together, even if it were established (which it has not been) that various aspects yield different effects and have different modes of operation. Also, the test for independence requires that the subject matter is not disclosed as being capable of use together; the Office Action appears to ignore this requirement and makes no finding about how the subject matter is disclosed.

In contrast to the Office Action’s conclusory and inadequate finding of independence, MPEP § 806.06 provides guidance, by example, of inventions that are claimed as independent (i.e. unrelated) (emphasis added):

Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions and different effects are independent. **An article of apparel and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.**

Applicants respectfully submit that any differences among the pending claims are not so extreme as those evident in comparing an article of apparel with a locomotive bearing, or a process of painting with a process of boring a well. Clearly, where all currently claimed embodiments are generally directed to processing related to credit accounts, no such independence exists.

Further, the Office Action’s own finding that the subject matter is all classified in Class 705 (with which Applicants do not necessarily agree or disagree) contradicts the conclusory finding of independence of the alleged inventions. The finding that an invention classified in 705/35 is somehow “unrelated” to one classified in 705/39 seems particularly inappropriate, given the hierarchical relationship and commonalities among those classifications (see the search results above).

2.04. The Office Action does not Meet the Prima Facie Burden for Establishing a Serious Search and Examination Burden

As noted above, the Office Action does not actually provide a specific reason, much less provide a rationale, as to why examination of all the claims

would be a serious burden. The lack of specificity in the reasoning means that no prima facie case has been made, much less one supported by substantial evidence.

C. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

We understand that a two-month extension of time to respond to the Office Action is necessary.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge: \$490.00

Deposit Account: 50-0271

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D. CONCLUSION

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mtdowns@walkerdigital.com.

Respectfully submitted,

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Date

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